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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/483,712	01/14/2000	Tongbi Jiang	3815US (98-0670)	8743
7590 Joseph A Walkowski TRASK BRITT & ROSSA P O Box 2550 Salt Lake City, UT 84110			EXAMINER WARREN, MATTHEW E	
			ART UNIT 2815	PAPER NUMBER
			MAIL DATE 06/24/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte: TONGBI JIANG AND EDWARD SCHROCK

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Application No. 09/483,712  
Technology Center 2800

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Mailed: June 24, 2008

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Before Krista Zele *Deputy Chief Appeals Administrator*.  
Zele, *Deputy Chief Appeals Administrator*.

ORDER RETURNING UNDOCKETED APPEAL

This application was received at the Board of Patent Appeals and Interferences on March 10, 2008. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the Examiner. The matters requiring attention prior to docketing are identified below.

APPEAL BRIEF

Related Appeals and Interferences

An examination of the application reveals that the “Related appeals and interferences” section of the Appeal Brief filed March 7, 2007, does not identify the prior related proceedings related to this application. It is noted that the Board of Patent Appeals and Interferences mailed a Decision on Appeal (No. 2004-2144) Affirmed, in this file on November 19, 2004.

37 CFR 41.37(c)(ii) states:

Related appeals and interferences. A statement identifying **>all** prior and pending appeals, judicial proceedings or interferences known to the appellant which may be related to, directly affect or be directly affected by or have a bearing on the Board’s decision in the pending appeal. Appellant includes the appellant, the appellant’s legal representative and the assignee. Such related proceedings must be identified by application number, patent number, appeal number (if available) or interference number (if available).< The statement is not limited to copending applications. **>**The requirement to identify related proceedings requires appellant to identify every related proceeding (e.g., commonly owned applications having common subject matter, claim to a common priority application) which may be related to, directly affect or be directly affected by or have a bearing on the Board’s decision in the pending appeal. Copies of any decisions rendered by a court or the Board in any proceeding identified under this paragraph must be included in an appendix as required by 37 CFR 41.37(c)(1)(x). If appellant does not identify any other items under this section, it will be presumed that there are none.

Summary Of Claimed Subject Matter

The “Summary of claimed subject matter” appearing on page 3 of the Appeal Brief filed March 7, 2007 is deficient because it does not map independent claims 1 and 2 to the specification.

According to 37 CFR § 41.37(c)(v), an Appeal Brief must include the following:

(v) *Summary Of Claimed Subject Matter*. A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which must refer to the specification by page and line number, and to the drawing, if any, by reference characters. While reference to page and line number of the specification requires somewhat more detail than simply summarizing the invention, it is considered important to enable the Board to more quickly determine where the claimed subject matter is described in the application. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of 37 CFR 41.37(c)(1)(vii), every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

#### Related Proceedings Appendix

The “Related Proceeding Appendix” section must include a copy of the Board of Appeals and Interferences Decision on Appeal (Appeal No. 2004-2144) mailed on November 19, 2004.

Correction is required.

#### EXAMINER’S ANSWER

The Examiner’s Answer mailed July 11, 2007, states that “[t]he examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or having a bearing on the Board’s decision in the pending appeal.” However, it should be noted that the Board of Appeals and Interferences mailed a Decision on Appeal (No. 2004-2144) Affirmed, in this file on November 19, 2004.

Correction is required.

MPEP § 1207.02 states in part:

(2) *Related Appeals and Interferences*. A statement identifying by application, patent, appeal or interference number all other prior and pending

appeals, interferences or judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by, or have a bearing on the Board's decision in the pending appeal. Copies of any decisions rendered by a court or the Board in any proceeding identified under this paragraph should be included in the *Related proceedings appendix* section.<

### CONCLUSION

Accordingly, it is

ORDERED that the application is returned to the Examiner to:

- 1) hold the Appeal Brief filed March 7, 2007 defective, as required by 37 CFR § 41.37(d);
- 2) notify the Appellant to submit a "paper" which corrects the Appeal Brief's Related Appeals and Interferences, Summary of Claimed Subject Matter and Related Proceedings Appendix under 37 CFR § 41.37(c);
- 3) acknowledge and consider any "paper" submitted by Appellant to correct the Appeal Brief;
- 4) issue and mail a PTOL-90 correcting the Related Appeals and Interference section as noted above; and
- 5) for such further action as may be appropriate.

If there are any questions pertaining to this Order, please contact the Board of Patent Appeals and Interferences at 571-272-9797.

Application No. 09/483,712

cc: Joseph A Walkowski  
TRASK BRITT & ROSSA  
P O Box 2550  
Salt Lake City, UT 84110